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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/501,197	03/09/2005	Hendricus Antonius Hoogland	294-192 PCT/US	3565
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HOFFMANN & BARON, LLP 6900 JERICHO TURNPIKE SYOSSET, NY 11791			GEHMAN, BRYON P	
			ART UNIT	PAPER NUMBER
			3728	

DATE MAILED: 11/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/501,197

Applicant(s)

HOOGLAND, HENDRICUS
ANTONIUS

Examiner

Bryon P. Gehman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date 7/23/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

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1. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. **The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided.** The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

3. The abstract of the disclosure is objected to because in lines 2 and 3, "receiving means" is improper legal phraseology. Correction is required. See MPEP § 608.01(b).

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 2-4 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it

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pertains, or with which it is most nearly connected, to make and/or use the invention.

Applicant sets forth the information carrier as having a longitudinal edge. However, the information carrier is disclosed as a disk-shaped structure which does not define a longitudinal direction thereof. Accordingly, the longitudinal edge of a circular structure is indefinite as to its meaning.

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 1, line 1, "platelike" is indefinite in what degree or manner the carriers are "like" a plate. See also claim 4, line 2. In line 2, "provided with a first and a second cover part" is indefinite as to which antecedent is being referred to and that two such parts are being defined, and should be --the device provided with a first cover part and a second cover part--. In lines 5 and 6, "the information carrier" is inconsistent or lacks antecedent basis for one such information carrier. In line 7, "the package" lacks antecedent basis and "its surface" lacks antecedent basis or clarity as to which antecedent is being referred to. In line 8, "the respective cover part" lacks basis for what "respective" refers to.

In claim 2, line 3, "a longitudinal edge of the information carrier" lacks basis for a longitudinal edge, as information carriers as disclosed are generally disk-shaped. See also claim 3, line 3.

In claim 4, line 2, the broad recitation "information carriers" is recited, and the claim also recites "such as CDs" which is the narrower statement of the range/limitation. A broad range or limitation together with a narrow range or limitation that falls within the broad range or limitation (in the same claim) is considered indefinite, since the resulting claim does not clearly set forth the metes and bounds of the patent protection desired. See MPEP § 2173.05(c). Note the explanation given by the Board of Patent Appeals and Interferences in *Ex parte Wu*, 10 USPQ2d 2031, 2033 (Bd. Pat. App. & Inter. 1989), as to where broad language is followed by "such as" and then narrow language. The Board stated that this can render a claim indefinite by raising a question or doubt as to whether the feature introduced by such language is (a) merely exemplary of the remainder of the claim, and therefore not required, or (b) a required feature of the claims. Note also, for example, the decisions of *Ex parte Steigewald*, 131 USPQ 74 (Bd. App. 1961); *Ex parte Hall*, 83 USPQ 38 (Bd. App. 1948); and *Ex parte Hasche*, 86 USPQ 481 (Bd. App. 1949). The phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). In lines 6 and 7, "the information carrier" lacks basis for one particular information carrier, as plural are referred to earlier in the claim.

In claim 5, line 3, "resilient elements" is inconsistent with lines 1-2. "at least one resilient element".

In claim 6, lines 1 and 3, "the or each" is indefinite, and --each-- should just be employed. See also claim 7, line 2 and claim 21, line 2. .

In claim 7, line 4, "the received position" lacks antecedent basis or consistency with previous terminology.

In claim 8, line 3, "its approximately flat outer side" lacks antecedent basis. In line 4, "the open and in the closed condition" lack antecedent basis. It is also unclear what "the open" is in any case.

In claim 9, lines 3 and 4, the phrase "preferably" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d). In line 5, the parenthesized phrase is also indefinite as to its effect and scope in defining the claim. These are again broad ranges mixed with narrower ranges as discussed above.

In claim 10, line 2, "the information carrier" returns to claim 1 for antecedent basis, where it was ambiguous what one information carrier was being referred to. In line 4, "the longitudinal direction of the back" lacks antecedent basis, as the back is insufficiently defined to distinguish a longitudinal direction thereof.

In claim 11, line 2, "the information carrier" returns to claim 1 for antecedent basis, where it was ambiguous what one information carrier was being referred to. In line 4, "the longitudinal direction of the back" lacks antecedent basis, as the back is insufficiently defined to distinguish a longitudinal direction thereof.

In claim 12, line 3, the phrase "in particular" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed

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invention. See MPEP § 2173.05(d). See also claim 13, line 2, claim 15, line 4, claim 19, line 2 and claim 20, line 2.

In claim 14, line 2, "the thickness" lacks antecedent basis for what such comprises. In line 3, the parenthesized dimensions are again indefinite as to being the same or different from "approximately to the dimensions of a standard DVD box".

In claim 15, line 2, "a cover part" is indefinite as to its relationship to the antecedent structure, to which it is not related by the claim. In lines 3-4, "of at least one outer surface" is indefinite as to what antecedent it is related to. In line 4, "the outer longitudinal edge" lacks antecedent basis as to what it relates to. In line 5, "the further respective outer surface" lacks antecedent basis.

In claim 16, line 2, "the first" should be followed by --cover part-- to be definite.

In claim 17, lines 2, the alternatives "in, on or as an inlay" are indefinite as to their scope and meaning.

In claim 18, line 1, "it" is indefinite as to which antecedent is being referred to. Also, "Jewel" should not be capitalized, and "jewel case-type" is indefinite as to what the metes and bounds are that render the intended "type".

In claim 21, line 3, "the inlay" lacks antecedent basis from parent claims 1 and 3-5.

In claim 22, line 1, "platelike" is indefinite in what degree or manner the carriers are "like" a plate. In line 2, "a first and a second cover part" is indefinite that two such parts are being defined, and should be --a first cover part and a second cover part--. In

line 4, "the information carrier" is inconsistent or lacks antecedent basis for one such information carrier. In line 5, "its" is indefinite which antecedent is being referred to.

In claim 24, line 2, "the inlay" lacks antecedent basis from claim 1.

In claim 25, lines 1-2, "a cover part" is indefinite, as its relation to the previously defined "cover part" is not distinguished. In line 2, "for instance through gluing" is again an indefinite range within a range.

In claim 26, line 2, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

In claim 27, line 1, "said cover part" lacks antecedent for one such part.

In claim 28, line 4, "its surface" is indefinite as to which antecedent is being referred to by "its". In line 5, "receiving means" lacks the required functional recitation to properly define the means. The word "means" is preceded by the word "receiving" in an attempt to use a "means" clause to recite a claim element as a means for performing a specified function. However, since no function with respect to any antecedent structure is specified by the word preceding "means," it is impossible to determine the equivalents of the element, as required by 35 U.S.C. 112, sixth paragraph. See *Ex parte Klumb*, 159 USPQ 694 (Bd. App. 1967).

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

9. Claims 1-11, 15-18, 21-22 and 24-28 are rejected under 35 U.S.C. 102(e) as being anticipated by Uchida (6,685,015). Claims 1-3, 7, 9, 11, 16 are rejected under 35 U.S.C. 102(b) as being anticipated by Kobayashi et al. (5,931,296). Claims 1-9, 11, 15-18, 21-22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Nesbitt et al. (5,662,216). Claims 1-9, 11, 15-18, 21-22 and 24-27 are rejected under 35 U.S.C. 102(b) as being anticipated by Uchida (5,593,031). Each discloses a device for packaging planar information carriers, the device provided with a first cover part (5; 21; 16; 4; respectively) and a second cover part (6; 45; 18; 5), with receiving means for engaging and locking an information carrier, the receiving means comprise guide elements (7-11; 61,65, 66; 36, 38, 54, 56; 3a, 3b, 8, 9) to guide and lock the information carrier, the information carrier can be slid into or under the guide elements, and the information carrier can be taken out by sliding it parallel with an outer surface thereof and a cover part.(5; 21; 16; 4).

As to claim 2, each discloses a resilient element (11; 65; 68 and 70 and parts adjacent thereto; 9, 9).

As to claim 3, each discloses rail-shaped elements (7-9; 61; 36, 38; 3a, 3b).

As to claim 4, Nesbitt et al. and the Uchida references disclose curved structures for a circular information carrier.

As to claims 5-6 and 21, Nesbitt et al. and the Uchida references disclose resilient elements (53 and 54; 11; 9; respectively)

As to claim 7, each discloses each cover part having a longitudinal dimension which in use an information carrier is slidable along the longitudinal dimension within the device.

As to claims 8 and 15, Nesbitt et al. and the Uchida references disclose the information carrier spaced from the cover parts.

As to claims 9, 11 and 26, each discloses molded cover parts joined by integrally molded hinges at a back of the device, the sliding direction of an information carrier being at right angles to the longitudinal direction of the back.

As to claims 10 and 11, Uchida ('015) discloses the alternatives in Figures 15 and 11, respectively.

As to claim 16, each cover part provides an area to receive an information carrier, so each defines receiving means in both cover parts. Nesbitt et al. further disclose receiving parts (including 68 and 70) on both cover parts.

As to claims 17, 22 and 24-25, Nesbitt et al. and the Uchida references disclose the receiving means provided as an inlay (14; 3).

As to claims 18 and 27, Nesbitt et al. and the Uchida references disclose the device as a jewel case.

As to claim 28, Uchida ('015) discloses a method for filling including a filling apparatus (robot, see column 4, line 62 through column 5, line 14).

10. Claim 23 is rejected under 35 U.S.C. 102(b) as being anticipated by any one of Nesbitt et al. and the Uchida references. Each discloses an inlay capable of being used in a device as claimed in claim 17 (see above). Claim 23 does not depend from claim 17 or further limit the subject matter thereof, but rather mentions the same for reference.

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 13-14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Nesbitt et al. and the Uchida references. To dimension the device of either one of Nesbitt et al. and the Uchida references to receive a DVD would have been obvious, as DVDs are commonly recognized information carriers in the present day.

13. Claim 9-11 are further rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Nesbitt et al. and the Uchida references in view of Whitehead et al.

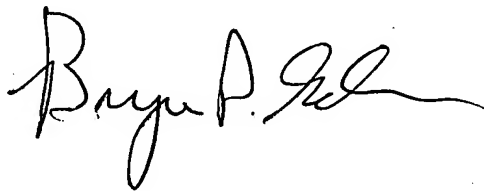
(5,168,991). To provide the device form a single structure incorporating a living hinge would have been obvious in order to make the device cover parts from a single molding, as suggested by Whitehead et al..

14. Claims 12 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over any one of Nesbitt et al. and the Uchida references in view of Kim (5,816,393). Kim discloses receiving means disposed in mirror image to receive information carriers in a stacked arrangement. To modify the receiving means of any one of Nesbitt et al. and the Uchida references employing the mirror image arrangement as taught by Kim would have been obvious in order to retain multiple information carriers in the device, as suggested by Kim.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bryon P. Gehman whose telephone number is (571) 272-4555. The examiner can normally be reached on Monday through Wednesday from 7:00 am to 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu, can be reached on (571) 272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Bryon P. Gehman
Primary Examiner
Art Unit 3728

BPG